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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,692

04/18/2005

Mark G. Gilreath

P-4437-US

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3769

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,692	<b>Applicant(s)</b> GILREATH, MARK G.	
	<b>Examiner</b> david shay	<b>Art Unit</b> 3769	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on February 10, 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on April 18<sup>th</sup>, 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>February 10, 2010</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

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The drawings are objected to because in Figure 1, none of the elements therein are labeled with indicia indicative of their function, additionally, Figure 1 appears to refer two separate Figures; in Figure 2, none of the elements therein labeled with indicia indicative of their function; in Figure 3, none of the elements therein are shown as connected and none labeled with indicia indicative of their function.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “handle and said blade being releasably interlockable with each other”; the “passageway through the handle and the blade”; the “imaging unit is connected to the blade”; and the “bivalve element” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The examiner will now discuss the Declarations submitted with the instant response.

The first Declaration (hereinafter the Gilreath Declaration), by the sole inventor, Mark Gilreath (hereinafter Declarant Gilreath), states the following. In paragraph 1, Declarant Gilreath discloses his date and location of birth. In paragraph 2, Declarant Gilreath discloses his education. In paragraph 3, Declarant Gilreath discloses his employment history with the assignee of the instant application. In paragraph 4, Declarant Gilreath states: "I am informed that the above identified application, which is owned..."; however, the remainder of the paragraph appears only to be the subordinate clause beginning "which..." thus the phrase consisting of paragraph 4 contains no object of which Declarant Gilreath was informed. In paragraph 5, Declarant Gilreath states that he has been informed of the previous office action and that it contained the rejection applied to the claims. In paragraph 6, Declarant Gilreath states that he has been informed of the effective date of the reference applied to the claims. In paragraph 7, Declarant Gilreath states that he submits the Gilreath Declaration to show that he conceived of the subject matter of the pending claims prior to March 21, 2002. In paragraph 7, Declarant Gilreath states that he "conceived of the subject matter of this application sometime in late 2001". And that Declarant Gilreath discussed "the conception and embodiments of this invention" in a meeting held in Israel", and that "shortly thereafter" the patent attorneys "began drafting a patent application for this invention, which underwent review and revision until its filing at the USPTO". In paragraph 8, Declarant Gilreath states that he has reviewed the Declaration of Rachel Bentov (hereinafter the "Bentov Declaration") and the attachments

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thereto, and states that the specification attached to the Bentov Declaration, saved on February 17, 2002 (hereinafter "Exhibit B"), is the first draft of the instant application. In paragraph 10, Declarant Gilreath reproduces the independent claims of the instant application. In paragraph 11, Declarant Gilreath states that he believes that the subject matter of all of these independent claims was conceived of by him, except for the concept of the handle and blade being releasably interlockable is disclosed in Exhibit B. In paragraph 12, Declarant Gilreath states that even though the concept of the handle and blade being releasably interlockable was not contained within the final draft submitted as Exhibit B, he recalls having discussed the concept at the meeting reference in paragraph 7. In paragraph 13, Declarant Gilreath states that he believes that the complete subject matter of all the independent claims was conceived by him prior to March 21, 2002.

The second Declaration - the Bentov Declaration, has been executed by Rachel Bentov (hereinafter Declarant Bentov) will now be discussed.

In paragraph 1, Declarant Bentov discloses her date and location of birth. In paragraph 2, Declarant Bentov discloses her education. In paragraph 3, Declarant Bentov discloses her employment history with regard to the entity which provided legal services regarding at least intellectual property to the assignee of the instant application. In paragraph 4, Declarant Bentov states that she became an independent contractor to her former employer, and acted as outside counsel to the assignee of the instant application. In paragraph 5, Declarant Bentov states that she became employed by the assignee of the instant application as Director of Intellectual Property. In paragraph 6, Declarant Bentov states that she is: "informed that the above identified application, which is owned..."; however, the remainder of the paragraph appears only to be the

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subordinate clause beginning “which...” thus the phrase consisting of paragraph 6 contains no object of which Declarant Bentov was informed. In paragraph 7, Declarant Bentov states that she has been informed of the previous office action and that it contained the rejection applied to the claims. In paragraph 8, Declarant Bentov states that she has been informed of the effective date of the reference applied to the claims. In paragraph 9, Declarant Bentov states that she submits the Bentov Declaration to show that Declarant Gilbreath conceived of the subject matter of the pending claims prior to March 21, 2002. In paragraph 10, Declarant Bentov states that “in late 2001” she attended a meeting “wherein the conception and embodiments of this invention were discussed” and that she “personally and directly participated in the preparation and revision of the provisional application of the instant application, the first of the revisions thereof being saved on her personal computer on February 17, 2002. In paragraph 11, Declarant Bentov states that she joined assignee as in house counsel in April of 2002 and transferred all the files relating to applications assigned to the assignee of the instant application to the databases of the assignee, and Declarant Bentov further states that she “made it a practice not to modify and save any of [the transferred] documents except as new documents. In paragraph 12, Declarant Bentov provides a screen snapshot of her “old documents” directory (hereinafter “Exhibit A”), noting the contents thereof and their dates. In paragraph 13, Declarant Bentov states that Exhibit B is a copy of the printout of intubation-draft1.doc saved February 17, 2002.

The examiner will now analyze the Declarations.

Regarding the Gilreath Declaration, the examiner has no comments concerning paragraphs 1-6, save that what Declarant Gilreath was averring to be informed of in paragraph 4 is not clear. Regarding paragraph 7, the examiner notes that it was Declarant Gilreath’s intention

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to show the conception of the claimed subject matter prior to March 21, 2002. Regarding paragraph 8, the examiner notes that Declarant Gilreath merely states that “conception and embodiments of this invention” were discussed, and makes no mention of the claimed invention. Regarding paragraphs 10-13, the examiner notes that Declarant Gilreath has not provided enough information to establish due diligence during the period between “late 2001” and February 17, 2002, nor during the period between February 17, 2002 and October 21, 2002.

Regarding the Bentov Declaration, the examiner has no comments concerning paragraphs 1-8, save that what Declarant Bentov was averring to be informed of in paragraph 6 is not clear. Regarding paragraph 9, the examiner notes that it was Declarant Bentov’s intention to show the conception of the claimed subject matter prior to March 21, 2002. Regarding paragraphs 10-13, the examiner notes that Declarant Bentov has not provided enough information to establish due diligence during the period between “late 2001” and February 17, 2002, nor during the period between February 17, 2002 and October 21, 2002.

In summary, while the while the Declarations show Declarants’ belief that the invention was conceived of prior to the effective date of the applied reference, the mere belief is insufficient to establish the factual constructive reduction to practice of the claimed invention, and further there is no showing of due diligence during the period between “late 2001” and February 17, 2002, nor during the period between February 17, 2002 and October 21, 2002. Thus the Declarations are insufficient to overcome the applied references.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mazzei et al (6840903 or 2003/0181789).

See Figures 1-4; column 3, line 1 to column 4, line 50, and paragraph [0016] to [0026]

Applicant's arguments filed February 22, 2010 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769